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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,701	06/29/2001	Randall H. Chance	27251-703	1522

21971 7590 07/27/2004

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EXAMINER

WONG, ALBERT KANG

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/897,701

Applicant(s)

CHANCE ET AL.

Examiner

Albert K Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. This application is a CIP of 09/897,700. Since applicant has not indicated that the claim subject matter is supported by the prior application, it is presumed that the priority date is the filing date of the instant application. Claims 1-37 are pending.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-32 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention.

Regarding claim 1, this claim is broader in scope than claim 1 in the parent application. In claim 1 of the parent, the claim recites a telemetry device coupled to a cathodic protection system. In the instant application, claim 1 recites a telemetry device monitoring a sensor. The monitoring function requires the coupling of the sensor to the telemetry device. Further, the recitation of a sensor is broader than the recitation of a cathodic protection system which constitutes a particular form of sensor. Since the prior claimed invention has been admitted to be on sale one year prior to the filing date of the parent application, the situation is similarly applicable.

Regarding claims 2-32 these claims are identical to claims 2-32 of the parent application and are similarly rejected based on the admission of prior use or sale.

4. Claims 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable based upon a public use or sale of the invention.

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Regarding claim 33, this claim is a broader combination of claims 1 and 39 of the parent application. Since it has been admitted that the various elements of claims 1 and 39 have been in public use or sale one year prior to the filing of the application the elements would constitute prior art. It would have been obvious to combine the same elements to a similar measurement device to achieve the same desired functionality inherent in the two claimed embodiments.

Regarding claims 34-36, these claims are identical to claims 39-42 of the parent application and are similarly rejected based on the admission of prior use or sale.

Regarding claim 37, the elements of the claims have been addressed in prior claims. It has been determined that the elements constitute prior art due to prior use or sale. The mixing of elements in a similar telemetry system is considered obvious since it is well known to interchange sensors and alarm function in various systems to add known features for their desired functions.

5. An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: Applicant must provide evidence concerning the facts pertaining to the public use or sale of the invention.

6. Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Albert K Wong whose telephone number is 703-305-8884. The examiner can normally be reached on M-Th.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Albert K. Wong
July 22, 2004